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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/830,992	05/03/01	LUBISCH	W 49500
			EXAMINER

HM22/0821

KEIL & WEINKAUF
1101 CONNECTICUT AVENUE NW
WASHINGTON DC 20036

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	5

1626

DATE MAILED:
08/21/01

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-28 and 30-38 are pending in the application.
- Of the above, claim(s) 27, 28 and 30-38 are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-26 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

09/830,992
* U.S. SPO 1:398-04-496

DETAILED ACTION

Claims 1-28 and 30-38 are pending in the application.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-26, drawn to products and method.

Group II, claim(s) 27, drawn to products.

Group III, claim(s) 28, drawn to a process.

Group IV, claim(s) 30-38, drawn to methods.

The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for

the following reasons: there is no significant structural element shared by all of the alternatives. Each of the groups set forth above represents a separate discrete heterocyclic ring system (see especially Groups I and II) which one skilled in the art which beside sharing no significant structural element, cannot be said to belong to a recognized class of chemical compounds in the pharmaceutical art. The claims are therefore considered to lack unity of invention.

During a telephone conversation with Herbert B. Keil on June 29, 2001, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-26. Affirmation of this election must be made by applicant in replying to this Office action. Claims 27, 28 and 30-38 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

It is suggested that in order to advance prosecution, the non-elected subject matter be cancelled when responding to this Office Action.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C.

112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 1:

- a) under the definition of R^1 , an "or" is needed after "hydrogen";
- b) under the definition of R^2 , an "or" is needed after " NH_2 ";
- c) under the definition of R^{24} , an "or" is needed after " NH_2 ";
- d) under the definition of R^4 , an "or" is needed after " $NH-CO-R^{43}$ ";
- e) under the definition of E, an "or" after "piperidine";
- f) under the definition of G, an "or" is needed before "morpholine";
- g) under the definition of R^{51} , an "or" is needed before " $(CH_2)_t-K$ ";
- h) under the definition of R^{52} , an "or" is needed before " $-C=N-NHR^{53}$ " and an open parenthesis is needed in the substituent;
- i) under the definition of R^{53} , an "or" is needed after "phenyl";
- j) the phrase "of one another one hydrogen of the" under the definition of R^{52} and R^{53} is unclear;

k) under the definition of R^{52} and R^{53} , the phrase "and two radicals form" should be changed to "or two radicals form";

l) an "or" should be added to separate the last substituent and the next to the last substituent under the definition of the B variable;

m) an "or" should be added to separate the last substituent and the next to the last substituent under the definition of the A variable;

n) an "or" should be added to separate the last substituent and the next to the last substituent under the definition of the R^{31} variable;

o) an "or" should replace the "and" to separate the last substituent and the next to the last substituent under the definition of the R^{32} variable;

p) an "or" should replace the "and" to separate the last substituent and the next to the last substituent under the definition of the R^{33} variable;

q) an "or" should be added to separate the last substituent and the next to the last substituent under the definition of the t variable;

r) the phrase "K is phenyl which may carry at most ^{two}~~ten~~ radicals R, is $NR^{k1}R^{k2}$ " under the definition of the K variable, is confusing;

s) an "or" should be added to separate the last substituent and the next to the last substituent under the definition of the R^5 variable;

t) an "or" should be added to separate the last substituent and the next to the last substituent under the definition of the R^7 variable;

u) an "or" should be added to separate the last substituent and the next to the last substituent under the definition of the R^{71} variable;

v) an "or" should be added to separate the last substituent and the next to the last substituent under the definition of the R^8 variable;

w) an "or" should be added to separate the last substituent and the next to the last substituent under the definition of the R^{81} variable;

x) an "or" should be added to separate the last substituent and the next to the last substituent under the definition of the R^9 variable; and

y) the phrase "and the tautomeric forms, possible enantiomeric and diastereomeric forms thereof, the prodrugs thereof and pharmacologically tolerated salts" should be changed to "or a tautomeric

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form, a possible enantiomeric or diastereoisomeric form, a prodrug or pharmacologically tolerated salt thereof". See claims 2-8 for same.

In claim 14, the phrase "stroke and" should be changed to "stroke or".

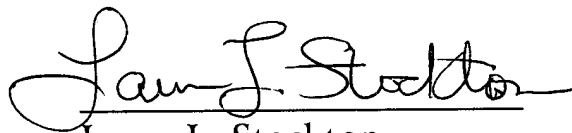
The instant claimed invention of claims 1-26 are free of the art of record since none of the prior art teach or suggest the substituents defined by the instant R³.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

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A facsimile center has been established. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or 305-3592.

A handwritten signature in cursive script, reading "Laura L. Stockton". The signature is written in dark ink and is positioned above the printed name.

Laura L. Stockton

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

August 17, 2001